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OFFICE OF PETITIONS

In re Application of :
Rendahl, Bogart, and Webster :
Application No. 09/818,684 : DECISION REFUSING STATUS
Filed: 28 March, 2001 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 47382.000122 :

This is in response to the petition under 37 CFR 1.47(b) filed on 28 December, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 28 March, 2001, without an executed oath or declaration.

Accordingly, on 30 May, 2001, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 28 December, 2001, the present petition and petition fee were filed, accompanied by, *inter alia*, a request and payment of the fee for a five (5) month extension of the time to reply to the "Notice" and a declaration naming Craig S. Rendahl, Kelley Bogart, and Jason Webster as joint inventors and

signed by Christopher Cuneo, petitioners' registered patent attorney for Environmental Systems Products Holdings., Inc. (ESP) on behalf of the non-signing inventors, a memorandum asserting proprietary interest on the part of ESP in the present patent application, and a copy of an employment agreement between Envirotech Systems Corp., Inc. (of which ESP is a parent organization).

Petitioners state that a copy of the application papers were sent the three joint inventors, but none has returned an executed declaration.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (5), and (6). In regards to item (1), petitioner has not provided sufficient proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) was sent or given to non-signing inventor Rendahl. Specifically, a bona fide refusal under Rule 47 requires that a copy of the application papers be sent to the non-signing inventor at that inventor's last known address, or, if the non-signing inventor is represented by counsel, to the address of the nonsigning inventor's attorney.¹

Petitioner should submit a copy of the cover letter transmitting the application papers to the non-signing inventor at the inventor's last known address or details given in an affidavit or declaration of facts by a person with first-hand knowledge of the details.

In regards to item (4), petitioners have not established that the Rule 1.47(b) applicant has sufficient proprietary interest in the

¹MPEP 409.03(d).

subject matter to justify the filing of the application.² The employment agreement submitted specifically identifies only joint inventor Rendahl. Petitioners have not shown sufficient proprietary interest with regards to the other inventors.

Petitioners may establish proprietary interest by filing a copy of the employment agreement between the non-signing inventors and the Rule 1.47(b) applicant (company); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

In regards to item (5), petitioner must provide proof of irreparable damages in accordance with MPEP 409.03(g).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

²MPEP 409.03(f).